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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,321	04/09/1999	WILLIAM W. BACHOVCHIN	19644-010	8452

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C. Hunter Baker, M.D., Ph.D.
Choate, Hall & Stewart
53 State Street
Exchange Place
Boston, MA 02109

EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 03/25/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/289,321

Applicant(s)
Bachovkin

Examiner
David Lukton

Art Unit
1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 7, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 73 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Pursuant to the directives of paper No. 25 (filed 1/7/03), claims 1 and 73 have been amended. Claims 1 and 73 remain pending.

Applicants' arguments filed 1/7/03 have been considered and found persuasive in part. The previously imposed §103 rejection is withdrawn.

*

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 73 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 73 is drawn to an oligomer in which there are a number of units each of which bears a boronate group. The numerical range of such units is 3-202. However, it does not appear that there is descriptive support for this range. In response, applicants have pointed to pages 52a, and 53. On page 53, it is stated that "n" is between 1 and 200, thus giving rise to a generic formula in which there can be between 2 and 201 boron-containing units. In the claimed genus, both the upper and lower limits have been modified, thereby creating a

new genus which was not previously described. There is no indication in the specification as filed as to how one could modify the upper or lower limit on the number of boron-containing units that are present.

A second issue pertains to the definition of $[J]_p$, $[I]_q$ and $[G]_m$. It is stated that $[J]_p$, $[I]_q$ and $[G]_m$ taken together comprise a linker moiety. However, it does not appear that there is support in the specification for this. What is stated on page 54 of the specification is that $[J]_p$, $[I]_q$ and $[G]_m$ taken **together with E2** comprise a linker moiety. That is not the same as what is now claimed.

*

Claims 1 and 73 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 73, the phrase "capable of forming" renders the claim indefinite as to whether the forming takes place. Applicants have argued that this term is no longer present. However, that conclusion is not accurate. For example, the term at issue occurs within the definition of E2.
- Claim 1 recites that "L" can have a weight of 2000 D, yet have a "length" of only 20 Å. How is this possible? In response, applicants have argued that this embodiment is excluded from the claims. However, there is no statement in the specification to this effect. But even if there were, then the next question would be, what about the case of "L" can having a weight of 2000 D, and a "length" of 40 Å. Is this included? What about the case of "L" having a weight of 2000 D, and a "length" of 60 Å ...? In short, it remains the case that claim 1 is very

unclear as to what is encompassed and what is not. The same issue applies in the case of claim 73, which also describes a linking group.

- Claim 1 recites each of the following:

“weight ranging between about 1100 D and about 2000 D”

“having a span ranging from about 20 Å to about 300 Å

However, the term “about” in each case introduces indefiniteness as to the upper and lower limits. Is the upper limit of the weight 2000 Daltons, or is the upper limit more than 2000 Daltons? It is suggested that the term “about” be deleted in these cases where a range is cited. The same deficiency afflicts claim 73. In response to this rejection, applicants have pointed to *Ex parte Eastwood*, 163 USPQ 316 (Bd. App. 1968) and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) as supporting the contention that the courts universally agree that the term “about” results in definite language, even when the term at issue is applied to a range. However, in *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991), the court found that claims reciting “at least about” were invalid for indefiniteness. Thus, there does not appear to be universal agreement among judges with regard to this matter. The rejection is maintained.

✱

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800



DAVID LUKTON
PATENT EXAMINER
GROUP 1800